

Amendments to the Drawings

The attached sheets of drawings include changes to Figures 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, and 49. The sheets which include Figures 38 and 39-40 replace the original sheet including Figures 38 - 40, and each sheet including Figures 41-49 replaces the original sheets including Figures 41-49, respectively. The figures have been formalized. No new matter has been added.

Attachment: Eleven (11) Replacement Drawing Sheets

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action mailed January 11, 2008. Claims 1-39 are pending with claims 1-16, 18, 23-28, 32, 33, 35, and 39 withdrawn from consideration. Claims 17 and 19 have been amended. Support for the amendments is found in the specification, claims, and drawings as originally filed. No new matter has been added. Reconsideration and allowance of the pending claims are respectfully requested.

Double-Patenting Rejections

Claims 17, 19-22, 29-31, 34, and 36-38 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 26 and 47 of U.S. Patent No. 6,800,084 in view of Zucherman et al. (U.S. Patent No. 6,074,390). Claims 17, 19-22, 29-31, 24, and 36-38 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 9, 17, and 25 of U.S. Patent No. 7,001,397 in view of Zucherman et al. (U.S. Patent No. 6,074,390). Claims 17, 19-22, 29-31, 24, and 36-38 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 and 16 of U.S. Patent No. 7,108,705 in view of Zucherman et al. (U.S. Patent No. 6,074,390).

Applicant does not concede the correctness of the double patenting rejections, however in the interest of furthering prosecution, Applicants will submit Terminal Disclaimers for US 7,001,397 and US 7,108,705 when the claims have otherwise been indicated as being allowable.

Independent claims 17 and 19, as amended, are believed to be non-obvious over Zucherman et al. as discussed below. Reconsideration and withdrawal of the rejection are respectfully requested.

35 U.S.C. §102 Rejection

Claims 17, 19-22, 29-31, 24, and 36-38 were rejected under 35 U.S.C. 102(b) as being anticipated by Zucherman et al. (U.S. Patent No. 6,074,390). Independent claims 17 and 19, as amended, recite, in part, the method step of expanding the distal portion of the access device. Zucherman et al. do not appear to teach or suggest such a step. Zucherman et al.

teach “a plurality of cannula can be used instead of one, with each cannula being slightly bigger than one before...Once the largest cannula is in place, and the opening of the skin accordingly expanded...”; see column 9, lines 48-55. Zucherman et al. thus appear to teach expanding the incision by inserting a series of increasingly larger cannula. Zucherman et al. do not teach expanding the distal portion of an access device, as is recited in independent claims 17 and 19. Zucherman et al. thus cannot be deemed to teach the identical invention as recited in the claims. Reconsideration and withdrawal of the rejection are respectfully requested.

35 U.S.C. §103 Rejection

Claims 17, 19-22, 29-31, 24, and 36-38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (U.S. Patent No. 6,074,390) in view of Davison et al. (U.S. Patent No. 6,187,000). The Examiner acknowledges that Zucherman et al. fail to teach expanding the distal end of an access device, but asserts that it would have been obvious to substitute the single cannula of Zucherman et al. with an expandable distal end to obtain the predictable results of increasing the cross-sectional area of the distal end of the access passage into the body. Applicants respectfully traverse the rejection.

Zucherman et al. appear to teach away from modifying their cannula to have an expanding distal end. Zucherman et al. specifically teach:

The cannula 258 is somewhat conical in shape with the nose end 266 being somewhat smaller than the distal end 268 in order to effect the insertion of the cannula into the space between the spinous processes.

See column 9, lines 43-47 and FIGS. 39-40. Applicants note that Zucherman et al.’s use of “distal end 268” refers to the proximal end of the cannula while “nose end 268” is actually the distal end of the cannula, as shown in FIGS. 39-40. In particular, FIGS. 39-40 clearly show the implant 260 being inserted through the wider end (268) of cannula 258 while the “nose end 266” is narrower and is actually at the distal end of the cannula. Zucherman et al. thus teach a cannula with a narrower distal end than the proximal end, which is the opposite structure as recited in the claims. Zucherman et al. thus teach away from the asserted modification to have an expandable distal end.

Further, in view of Zucherman et al.'s specific teaching that a narrower nose is desired "in order to effect the insertion of the cannula into the space between the spinous processes", there is no motivation for one of ordinary skill in the art to modify the cannula to have an expandable distal end. Such a modification would appear to destroy the functionality of the device.

MPEP 2143.01 III states

The mere fact that references can be combined or modified does not render the resultant combination obvious unless **>the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007)("If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.").

It appears the Examiner is relying on the mere fact that Zucherman et al. and Davison et al. could be combined, or that Zucherman et al. could be modified, as the motivation for obviousness, which is improper. Additionally, Applicants submit that in view of Zucherman et al.'s teaching of the desirability of a narrower distal end, there is no reasonable expectation of success in modifying the cannula of Zucherman et al. as asserted by the Examiner. Reconsideration and withdrawal of the rejection are respectfully requested.


Conclusion

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

By his attorney,

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